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09/918,841	07/31/2001	Marija V. Bulatovic	05423.00001	3943

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Debra J. Fickler
12525 Grandview Drive
Huntley, IL 60142

EXAMINER

BEKERMANN, MICHAEL

ART UNIT	PAPER NUMBER
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3622

DATE MAILED: 10/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/918,841

Applicant(s)

BULATOVIC ET AL.

Examiner

Michael Bekerman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-37 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 July 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 7/31/01
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____

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DETAILED ACTION

Drawings

1. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "304" has been used to designate both memory device and radio receiver. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

2. The drawings are objected to because Figure 7 is unreadable. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency.

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Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

3. In addition to Replacement Sheets containing the corrected drawing figure(s), applicant is required to submit a marked-up copy of each Replacement Sheet including annotations indicating the changes made to the previous version. The marked-up copy must be clearly labeled as "Annotated Sheets" and must be presented in the amendment or remarks section that explains the change(s) to the drawings. See 37 CFR 1.121(d)(1). Failure to timely submit the proposed drawing and marked-up copy will result in the abandonment of the application.

Claim Objections

4. Claim 14 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. This claim mixes statutory classes and fails the infringement test in MPEP 608.01(n) as being an improper dependant claim. A CD-ROM having instructions to perform the method step would infringe claim 14, but not the method claim since the CD-ROM itself only stores steps, it

does not perform them. Mere possession of such a CD-ROM would infringe claim 14, but not the associated method claim.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. **Claims 1, 2, 4, 5, 8-10, 14-17, 19, 21- 26, 29, 33-35, and 37 are rejected under 35 U.S.C. 102(e) as being anticipated by Barnett (U.S. Patent No. 6,321,208).**

Barnett shows a method and system for downloading advertisements and selectively displaying them in an offline environment that includes all of the limitations as recited in the above claims.

7. Regarding claims 1, 2, 4, and 14, Barnett teaches a computer readable medium and method for: connecting to a remote network (Column 7, Lines 2-5), requesting information from the remote network (Column 7, Lines 2-5), receiving user-requested advertising information from the remote network (Column 8, Lines 23-25 and 29-33), storing the received information in a memory location (Column 8, Lines 29-33), and selectively displaying stored information while disconnected from the remote network (Column 9, Lines 26-28). Examiner considers Barnett's coupons to be advertisements.

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8. Regarding claim 5, Barnett teaches a method of compiling keywords and an associated index for referencing the information received from the network and stored in the memory location (Column 10, lines 5-13). Examiner considers the name of each category and subcategory to be a keyword that can be associated with each coupon. Due to the program's ability to return coupons according to selectable keyword criteria, a keyword index is inherent.

9. Regarding claims 8-10, Barnett teaches a method of monitoring a user's actions which includes: comparing words displayed on the electric display with words in a keywords index (Column 10, Lines 18-21), and recalling from a memory location information associated with the keywords index when a word on the electronic display matches a word in the keywords index (Column 10, Lines 22-24). Due to the program's ability to return coupons according to selectable keyword criteria, a keyword index is inherent.

10. Regarding claims 15-17, and 19, Barnett teaches an electronic display device comprising: means for coupling to an internet network and receiving advertising information to be selectively displayed (Column 8, Lines 52-55), a memory having stored therein the received information to be selectively displayed (Column 8, Lines 60-64), a display for displaying the received information to be selectively displayed stored in memory (Column 8, Line 57), and means for (computer processor) monitoring actions of a user to select which received information it to be displayed (Column 8, Line 57). Examiner considers a computer processor to be a memory reader.

11. Regarding claim 21, Barnett teaches a memory having stored therein a keywords index (Column 10, Lines 5-13) and a means for monitoring that utilizes the keywords index to select the information to be displayed (Column 10, Lines 18-24). Examiner considers the name of each category and subcategory to be a keyword that can be associated with each coupon. Due to the program's ability to return coupons according to selectable keyword criteria, a keyword index is inherent.

12. Regarding claim 22, Barnett teaches a server comprising: means for coupling to an electronic display device via a network (Column 6, Lines 66-67, and Column 7, Lines 1-5), means for providing information to be selectively displayed on the electronic device (Column 6, Lines 66-67, and Column 7, Lines 1-5), and means for providing a keywords index to the electronic display device (Column 8, Lines 2-5, and Column 10, Lines 5-24). Examiner considers the name of each category and subcategory to be a keyword that can be associated with each coupon. Due to the program's ability to return coupons according to selectable keyword criteria, a keyword index is inherent.

13. Regarding claim 23, Barnett teaches a method implemented by a server for receiving a request for information from a display device via a network (Column 6, Lines 66-67, and Column 7, Lines 1-5), providing advertising information to a display device (Column 6, Lines 66-67, and Column 7, Lines 1-5), and providing a keywords index to the display device (Column 8, Lines 2-5, and Column 10, Lines 5-24). Examiner considers the name of each category and subcategory to be a keyword that can be associated with each coupon. Due to the program's ability to return coupons according to selectable keyword criteria, a keyword index is inherent.

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14. Regarding claim 24, Barnett teaches a method implemented by a server for receiving a request for information from a display device via a network (Column 7, Lines 62-67), comparing words in the requested information with words in a keywords index to identify targeted advertising info (Column 7, Lines 62-67), providing the requested information (coupon management program) for display (Column 8, Lines 2-5), and providing the identified targeted advertising information for display (Column 9, Lines 54-56).

15. Regarding claims 25 and 26, Barnett teaches a method implemented by an electronic display device for receiving an indication from a user to display information (shopping list) stored in memory, displaying the information in accordance with the user indication (Column 10, Lines 18-21), identifying at least one targeted advertisement stored in memory using a keyword index to correlate at least one word from the information with one targeted advertisement (Column 10, Lines 22-24), and displaying the targeted advertisement (Column 10, Lines 22-24).

16. Regarding claim 29, Barnett teaches a computer readable medium having computer-executable instructions for: connecting to a remote network (Column 7, Lines 2-5), requesting information from the remote network (Column 7, Lines 2-5), receiving information from the remote network (Column 8, Lines 23-25 and 29-33), receiving a keywords index from the remote network and compiling a listing of words and an associated index for referencing the received information (Column 10, lines 5-13), storing the received information in a memory location (Column 8, Lines 29-33), monitoring actions of the user involving the comparing of words displayed on the screen

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with words in a keywords index (Column 10, Lines 18-24), and selectively displaying stored information while disconnected from the remote network (Column 9, Lines 26-28). Examiner considers the name of each category and subcategory to be a keyword that can be associated with each coupon. Due to the program's ability to return coupons according to selectable keyword criteria, a keyword index is inherent.

17. Regarding claims 33-35, Barnett teaches an advertising display apparatus comprising: an external data receiver (modem) (Column 8, Lines 52-55), a memory device (hard disk drive) (Column 8, Lines 63-64), a memory data extractor (processor) (Column 10, Line 57), a display device (Column 10, Line 57), and a connector port (Column 8, Lines 52-55). Due to the display data being stored on a hard disk drive, it is an inherent feature that the display data is embodied as magnetic media.

18. Regarding claim 37, Barnett teaches a method for displaying advertising indicia comprising: providing indications of advertising data to be displayed (Column 6, Lines 66-67, and Column 7, Lines 1-5), storing the indications provided (Column 8, Lines 29-33), and selectively extracting and displaying the indications (Column 9, Lines 26-28 and Column 10, Lines 18-24).

Claim Rejections - 35 USC § 103

19. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

20. Claims 3, 6, 7, 11-13, 18, 27, 28, and 30-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barnett (U.S. Patent No. 6,321,208) in view of De Rafael (U.S. Pub. No. 2002/0116256).

21. Regarding claim 3, Barnett teaches advertising information that includes a keywords index and at least one advertisement, but doesn't specify an advertising summary. Barnett shows the advertisements being returned in a list format (Column 10, Lines 5-24) and it is well known that when a list of items is displayed for selection, each item will have some type of summary information associated with it to aid in the selection process. De Rafael teaches an advertising database that allows the user to select an advertisement for viewing from a list of advertisements by displaying a list of titles and an accompanying descriptive phrase (Paragraph 0012). It would have been obvious to one having ordinary skill in the art at the time the invention was made to include an advertising summary into Barnett's invention. This would allow users to have a better understanding of the advertisement they are about to select.

22. Regarding claims 6 and 7, Barnett teaches the displaying of user requested information, performing a keywords search (Column 10, Lines 18-24), and displaying an advertisement. Barnett doesn't specify an advertising summary. Barnett shows the advertisements being returned in a list format (Column 10, Lines 5-24) and it is well known that when a list of items is displayed for selection, each item will have some type of summary information associated with it to aid in the selection process. De Rafael teaches an advertising database that allows the user to select an advertisement for viewing from a list of advertisements by displaying a list of titles and an accompanying

descriptive phrase (Paragraph 0012). It would have been obvious to one having ordinary skill in the art at the time the invention was made to include an advertising summary into Barnett's invention. This would allow users to have a better understanding of the advertisement they are about to select.

23. Regarding claims 11-13 and 30-32, Barnett teaches an input device for selecting and displaying advertisements (Column 8, Lines 55-56). Barnett doesn't specify an advertising summary. Barnett shows the advertisements being returned in a list format (Column 10, Lines 5-24) and it is well known that when a list of items is displayed for selection, each item will have some type of summary information associated with it to aid in the selection process. De Rafael teaches an advertising database that allows the user to select an advertisement for viewing from a list of advertisements by displaying a list of titles and an accompanying descriptive phrase (Paragraph 0012). It would have been obvious to one having ordinary skill in the art at the time the invention was made to include an advertising summary into Barnett's invention. This would allow users to have a better understanding of the advertisement they are about to select.

24. Regarding claim 18, Barnett doesn't specify an advertising summary. Barnett shows the advertisements being returned in a list format (Column 10, Lines 5-24) and it is well known that when a list of items is displayed for selection, each item will have some type of summary information associated with it to aid in the selection process. De Rafael teaches an advertising database that allows the user to select an advertisement for viewing from a list of advertisements by displaying a list of titles and an accompanying descriptive phrase (Paragraph 0012). It would have been obvious to one

having ordinary skill in the art at the time the invention was made to include an advertising summary into Barnett's invention. This would allow users to have a better understanding of the advertisement they are about to select.

25. Regarding claims 27 and 28, Barnett teaches the receiving of an indication from a user to display details of an advertisement and the displaying of the details (Column 9, Lines 54-56). Barnett doesn't specify an advertising summary. Barnett shows the advertisements being returned in a list format (Column 10, Lines 5-24) and it is well known that when a list of items is displayed for selection, each item will have some type of summary information associated with it to aid in the selection process. De Rafael teaches an advertising database that allows the user to select an advertisement for viewing from a list of advertisements by displaying a list of titles and an accompanying descriptive phrase (Paragraph 0012). It would have been obvious to one having ordinary skill in the art at the time the invention was made to include an advertising summary into Barnett's invention. This would allow users to have a better understanding of the advertisement they are about to select.

26. Claims 20 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barnett (U.S. Patent No. 6,321,208) in view of Ferber (U.S. Pub. No. 2002/0004746).

27. Regarding claims 20 and 36, Barnett doesn't teach the use of a wireless connection in the method and system for downloading advertisements. Ferber teaches a wireless device for the delivery, storage, and sorting of advertisements (E-coupons) (Paragraph 0008). It would have been obvious to one having ordinary skill in the art at

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the time the invention was made to use Ferber's wireless device as Barnett's display device. This would allow Barnett's invention to be used anywhere, and not in just one location. A radio receiver for receiving radio signals is an inherent feature in wireless portable user devices.

Conclusion

28. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The following references are cited to further show the state of the art with respect to downloadable targeted advertisements:

U.S. Patent No. 5,913,040 to Rakavy

U.S. Pub. No. 2005/0005242 to Hoyle

WO 01/69480 to Cho

WO 00/63804 to Joo


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Bekerman whose telephone number is (571) 272-3256. The examiner can normally be reached on Monday - Friday, 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric W. Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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JEFFREY D. CARLSON
PRIMARY EXAMINER